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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,430	10/21/2003	Brett Allison Taylor		3833

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CLAYTON, MO 63105

EXAMINER

PRONE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,430

Applicant(s)

TAYLOR, BRETT ALLISON

Examiner

Christopher D. Prone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 30-41 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) 5, 15, 25 and 37-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-48 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-20, 22-24, 26, 27 and 30-36 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 19 and 20 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 19 the examiner still does not understand what the applicant is attempting to claim on lines 4-7. The recitation that the opening is larger in a rotational direction about the pivot remains unclear. The examiner maintains that someone of ordinary skill in the art would not understand this claim language. The claim is considered to be indefinite and has been rejected over the art as best understood below.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "76" has been used to designate both a lower surface of the spacer and a inner surface of a through hole in the spacer, shown in figure 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted

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after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 13, and 30-33, are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,129,763 Chauvin et al.

Chauvin discloses the same invention being a vertebral disk prosthesis comprising a member (1) having lateral portions (5) having keyway portions (19) flexibly coupled together through a central portion (7), and an expansion wedge member (2) having a key portion (18) configured to move the lateral members between compressed and expanded states corresponding to the periphery of a vertebral body.

Claims 34-36, are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,674,295 Ray et al.

Ray discloses the same invention being a vertebral disk prosthesis comprising first and second members (10) that are expandable in lateral and axial direction by the expansion of a bushing gel disposed between and in supportive association with the contacting members.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12, 14, 16-20, 22-24, 26, 27, and 44, are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,835,206 B2 Jackson.

In reference to claims 1-4, 6, 9, 10, 14, 24, 28-33, 44, Jackson discloses the same invention being a vertebral disk prosthesis comprising a member (10) having lateral portions (21) and (22), flexibly coupled together through a central portion (16), a gripping portion (23), and an expansion wedge member (12) having an inclined surface (50) configured to move the lateral members between compressed and expanded states corresponding to the periphery of a vertebral body.

In reference to claims 7 and 8 Jackson discloses a threaded fastener (13) connected between the wedge (12) and a member (10).

In reference to claims 11 and 12 Jackson discloses that the wedge portion may comprise a ratchet member for resisting withdrawal movement of the wedge shown in figures 25-31 as members (433) and (451).

In reference to claims 16-20 Jackson discloses pivotally connected top and bottom end plates (the side surfaces of lateral portions 10 and 11) with a central portion (32), a pivot limiter (13) with a central portion (64) attached to the other member and a sloped surface (62) for allowing and limiting movement between the endplates and the limiter about a universal pivot.

In reference to claims 22 and 23 Jackson discloses a spacer (13) including a central portion (62) that the lateral portions are movably coupled to.

In reference to claims 26 and 27 Jackson discloses first and second living hinges (10) and (11).

Response to Arguments

Applicant's arguments filed 5/16/06 have been fully considered but they are not persuasive.

The applicant argues that Chauvin is incapable of expanding sufficiently to reach the lateral sides of the periphery of the vertebral body and is incapable of providing the surprising benefits from the claim invention. However the implant of Chauvin is fully capable of expanding to reach the lateral sides of the periphery of the vertebral body because there are various sizes of vertebral bodies. If a large enough implant and

small enough vertebra were used the implant would clearly expanding to reach the lateral sides of the periphery of the vertebral body.

The applicant further argues that the cage disclosed by Jackson is only moved in an axial direction not a lateral direction. However the device of Jackson could be used on its side therefore making its expansion in a lateral direction.

The applicant argues that Jackson does not disclose structure of claim 10 because he fails to disclose moving portions in 2 different directions. However the claims do not recite requirement for movement in 2 different directions.

The applicant argues that figure 25 of Jackson does not disclose a ratchet. However according to the applicant's explanation of a ratchet Jackson simply discloses a ratchet comprising a single tooth. Jackson clearly shown a tooth (431) and a pawl (442) that is allowed to move forward, but is not permitted to move in reverse.

Applicant's arguments with respect to claims 16 have been considered but are moot in view of the new ground(s) of rejection. The examiner has better defined the end plates as being the side surfaces of the lateral members (10) and (11) (located near the reference numbers (32) and (23) shown in figure 1) that are therefore pivotally connected at end (16).

Allowable Subject Matter

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 45-48 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CDP

Christopher D Prone
Examiner
Art Unit 3738


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